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JOHN EDWARD ROETHEL 2290 S. JONES BLVD. #100 LAS VEGAS, NV 89146			COBURN, CORBETT B	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/923,673
Filing Date: August 06, 2001
Appellant(s): SINGER ET AL.

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John E. Roethel
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 30 May 2004 appealing from the Office action mailed 19 August 2003.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

None

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is deficient. 37 CFR 41.37(c)(1)(v) requires the summary of claimed subject matter to include: (1) a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number, and to the drawing, if any, by reference characters and (2) for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. The brief is deficient because it does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number, and to the drawing, if any, by reference characters. While the independent claims are listed, the Summary fails to point out the location in the specification of each limitation using page and line numbers or reference characters. Furthermore, Appellant failed to describe each of the claims argued separately.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Patents to Gatley et al. (GB 2,239,547), Piechowiak (US Patent Number 6,012,982), Itkis (US Patent Number 6,227,969), and Thomas et al. (US Patent Number 6,190,255) as well as the definition of "slot machine" contained in the Nevada Revised Statutes, 463.0191.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7, 10, 19, 20 & 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gatley et al. (GB 2,239,547) in view of Piechowiak (US Patent Number 6,012,982) and Itkis (US Patent Number 6,227,969).

Claims 1, 25: Gatley teaches a gaming device in which each slot game has a plurality of reels, a plurality of symbols associated with each reel – i.e., a "fruit machine". (Abstract) Gatley's gaming machine having at least a first slot game and second slot game thereon. (Abstract) The first slot game to operates independently of the second slot game with

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regard to the activation of the slot reels, the display of the symbols on each reel and the determination of an outcome on each pay line and there is a common pool of credits from which each slot game uses credits to make wagers and to which each slot game accrues awards from any winning occurrences on the slot game. (Page 2)

Gatley does not, specifically teach a plurality of pay lines for each game.

Multiple paylines are extremely well known in the art. Piechowiak teaches multiple paylines. (612-614) Having multiple paylines encourages players to bet more money on each game because the chance of winning increases with the amount bet. This increases the casino's profits. It would have been obvious to one of ordinary skill in the art at the time of the invention to have each game have multiple paylines in order to encourage players to bet more money on each game, thus increasing the casino's profits.

Gatley fails to teach displaying the multiple games on a single video monitor.

Itkis displays multiple games on a single screen. (Fig 4) Having a single video display screen instead of multiple screens would reduce the cost of Gatley's invention. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Gatley in view of Itkis to use a single video display in order to reduce costs.

Claims 2, 26: Gatley teaches using a separate input means to make a wager on each slot game and using a separate means to activate the start of each slot game. (Control buttons, page 2, line 25) Each game comes with a separate display panel (p 2, 25), which is a separate means to allow a player to view an explanation of the operation, rules and payouts for each game. Gatley indicates that a common credit register may be provided (p 2, 32-34), this implies that separate registers to allow the player view the wager made,

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the credits accrued and other information pertinent to the operation of each game may also be provided. Gatley teaches using a common control means to allow the player to receive a payout of any amount of accrued credits. (p 2, 34-36)

Claim 3: It is clearly possible for each of Gatley's games to be the same game in every aspect, including having the same set of rules, symbols, pay lines, wagers, music, artwork and random number generator.

Claim 4: Gatley states that each module may provide a different game. (p 3, 24-25)

Thus each game may be a different game in one or more aspects, including having a different set of rules, symbols, pay lines, wagers, music, artwork or random number generator.

Claim 5: Clearly each of the slot games on Gatley's gaming machine may be selected by a manufacturer of the gaming machine.

Claim 6: Since Gatley discloses removing and replacing games (p3, 19-25), each of the slot games on the gaming machine may be selected by a gaming establishment who is acquiring the gaming machine.

Claim 7: Gatley discloses displaying both available games for the player to choose from. This is equivalent to providing that each of the slot games on the gaming machine is selected by the player of the gaming machine from a menu of available games provided on the gaming machine.

Claim 10: Piechowiak teaches that each slot game includes randomly selecting and displaying one or more pay lines of at least three symbols (Fig 6). Piechowiak teaches the player making a first wager on a first pay line, a second wager on a second pay line

and additional wagers on any subsequent pay lines by drawing from the common pool. If the resulting symbols of any pay line comprise a predetermined winning combination, to the common pool is credited a predetermined amount based on the amount of the corresponding wager. The player takes money from a common pool (the player's bankroll) and the common pool (the bankroll) is credited by any winnings – i.e., the player puts the money in his pocket. Furthermore, Gatley teaches a common credit register (p2, 31-36) from which bets are taken and to which winnings are paid.

Claims 19, 27: Gatley teaches the invention substantially as claimed, but does not teach a bonus game. Piechowiak teaches providing each slot game with a bonus screen feature which is activated if at least one predetermined symbol appears on an active pay line on the slot game screen display. (Col 1, 59-62) Piechowiak teaches that with a bonus game, “the players enjoy a heightened interest and enthusiasm in the gaming machine” that “translates into higher revenue for gaming machine proprietors”. (Col 1, 38-43) It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided each slot game with a bonus screen feature which is activated if at least one predetermined symbol appears on an active pay line on the slot game screen display in order to allow the players to “enjoy a heightened interest and enthusiasm in the gaming machine” that “translates into higher revenue for gaming machine proprietors”.

Claim 20: Piechowiak teaches that there are one or more predetermined features (e.g., bonus screen features). (Col 3, 54-55) Piechowiak also teaches that the bonus screen feature is selected randomly from this plurality of possible bonus screens. (Col 4, 63-65)

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3. Claims 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gatley, Piechowiak and Itkis as applied to claim 19 above, and further in view of Thomas et al. (US Patent Number 6,190,255).

Claim 21: Gatley, Itkis, and Piechowiak teach the invention substantially as claimed, but does not teach a “pick-em” game. Thomas teaches such a game. Thomas teaches displaying at least two objects on a bonus screen (Fig 8). The player selects a bonus screen object which reveals an award to the player (the number symbols in Fig 9) until the player selects a bonus screen object that causes the bonus screen feature to end (the “Party Pooper” symbols in Fig 9) and accruing to the common pool of credits the total accumulated amount of the award achieved by the player during the play of the bonus screen feature. (Col 10, 25- Col 11, 13) “Pick-em” games are popular because players feel they have more control over the outcome. It would have been obvious to one of ordinary skill in the art at the time of the invention to have implemented the bonus screen feature as a “Pick-em” game (as described in Thomas and immediately above) in order take advantage of the popularity of such games by allowing the players to feel they have more control over the outcome.

Claim 22: Piechowiak teaches the bonus screen award includes a special feature award in which the player receives an award based on the total amount wagered by the player. (Col 9, 22-24)

Claim 23: Thomas discloses randomly selecting from a group of possible multiplier numbers. (Col 5, 35-62) Thomas teaches that “bonus resources” are randomly chosen outcomes of the game and that they may be bonus multipliers.

Claim 24: Thomas teaches that the special feature award is an amount calculated to result in an average value that can be utilized to control the overall average payout of the gaming machine. (Fig 7)

(10) Response to Argument

Examiner's Summary

Appellant has attempted to overcome the rejection of the claims under 35 USC §103(a) by a piecemeal analysis of each of the prior art references. Appellant fails to address the teachings of the combination of the references as a whole. It is Examiner's contention that taken as a whole, the combination of the references would have suggested Appellant's claimed invention to one of ordinary skill in the art at the time of the invention.

Arguments re: First Group of Claims

Appellant states that the group stands and falls with Claim 1.

Appellant states that Claim 1 requires a single main screen used to display a first and second slot game and states that Gatley fails to teach this feature. Examiner concurs. Had Gatley taught this, Gatley might well have anticipated the claimed invention.

Appellant then argues that the claimed invention has numerous advantages over that disclosed by Gatley. This is a spurious argument. These advantages are not claimed.

Appellant then discusses Piechowiak's disclosure that a slot machine may have multiple paylines. Appellant points out that this does not overcome the deficiency in Gatley.

Then Appellant discusses Itkis – which does teach displaying multiple games on one screen. Appellant states that Itkis does not teach displaying two *slot machine* games on the same screen.

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Appellant is incorrect for a number of reasons.

First, Itkis states:

It should be clearly understood without a restriction of the scope of this invention that games other than bingo, poker, blackjack, and keno as mentioned above can be played with the help of the suggested game network. Moreover, the slave game device 7 could play simultaneously a number of games of the same type. For example, a player could be playing two or more bingo games at once, specifically one local bingo game restricted to a specific location (e.g. a single casino) and a regional bingo game (e.g. a game encompassing several casinos). (Col 5, 34-43)

Clearly, a slot machine game would fall into the category of “games other than bingo, poker, blackjack, and keno”. Furthermore, Itkis claims a slot machine game – and the claim is considered part of the disclosure.

Second, and more importantly, Itkis does teach a slot machine game. According to the definition recognized in the art:

“Slot machine” means any mechanical, electrical or other device, contrivance or machine which, upon insertion of a coin, token or similar object, or upon payment of any consideration, is available to play or operate, the play or operation of which, whether by reason of the skill of the operator in playing a gambling game which is presented for play by the machine or application of the element of chance, or both, may deliver or entitle the person playing or operating the machine to receive cash, premiums, merchandise, tokens or any thing of value, whether the payoff is made automatically from the machine or in any other manner. (Nevada Revised Statutes, 463.0191)

Clearly, Itkis teaches a displaying two slot machine games on a single screen. And even if Itkis did not teach slot machine games, both Gatley and Piechowiak teach slot machine games.

Appellant has argued each reference individually while ignoring what is plainly taught by the combination. One cannot show nonobviousness by attacking references individually

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where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). At no point does Appellant address the teachings of the combination of references.

After arguing that Itkis fails to teach multiple slot machine games, Appellant goes to great lengths to discuss features of Itkis that are not in Appellant's claims. Yet the claims are open ended – the fact that Itkis teaches additional features not claimed by the Appellant is immaterial. The question is, what would the combination of Gatley, Piechowiak, and Itkis teach or suggest to one of ordinary skill in the art? Appellant has avoided addressing this question.

Appellant argues that Itkis would not have suggested to one of ordinary skill in the art to display a first slot machine game and a second slot machine game independently on the same video screen to a single player. (Appeal Brief, page 10, lines 13-15.) Yet Figure 4 clearly shows displaying a first slot machine game and a second slot machine game (and even a third slot machine game) independently on the same video screen to a single player. Surely, this would have been a powerful suggestion to one of ordinary skill in the art.

Appellant makes a great deal of the fact that Itkis teaches a central computer in communication with “dumb terminals”. Yet what is a “dumb terminal”? It is a video screen with an input device (i.e., a keyboard or keypad). Isn't that the same structure taught by Gatley and the Appellant? A central computer (i.e., the processor) is connected to a video screen that is associated with an input device. Surely, Appellant is not asserting that the fact that the dumb terminals in Itkis are in a separate box from the processor means that one of

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ordinary skill in the art could not have considered the teachings of Itkis in combination with those of Gatley and Piechowiak.

Appellant states that the only suggestion that can be gleaned from Itkis is to display the same results of two slot games to each player on his dumb terminal. This is based on a misreading of Itkis. Itkis's Fig 4 shows three independent games on the screen. The results of the poker game are not the same as the keno results or the bingo results. Nor are the bingo and keno results related. These games are totally independent of each other. Furthermore, Gatley teaches two independent slot machine games. Even if Itkis did not teach two independent slot machine games (which it does), the combination of Gatley and Itkis would teach, while the combination of Gatley, Piechowiak and Itkis would teach displaying at least two independent slot machine games with multiple paylines on a single screen – i.e., the claimed invention. Appellant, however, fails to address the combination of references.

Conclusion

Appellant has argued each reference independently, but has failed to address the teachings of the combination of references as a whole. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Therefore, Examiner's rejection of claims 1-7, 10, 19, 20 & 25-27 should be affirmed.

Arguments re: Second Group of Claims

Appellant argues that claims 21-24 should stand and fall with claim 1. As pointed out above, Examiner's rejection of claims 1-7, 10, 19, 20 & 25-27 should be affirmed because

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Appellant fails to address the teachings of the combination of references as a whole.

Appellant then argues that Thomas does not teach displaying multiple slot machine games on a single screen. Again, this does not address the teachings of the combination taken as a whole. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Therefore, Examiner's rejection of claims 21-24 should be affirmed.

Conclusion

Since Appellant has failed to address the teachings of the prior art as a whole, Appellant has failed to overcome Examiner *Prima Face* case for obviousness. Examiner respectfully requests that the Board of Appeals affirm the rejection of claims 1-7, 10 & 19-27.


Respectfully submitted this 21st day of October 2005.



Corbett B. Coburn III
Examiner

Conferees:

Xuan Thai 
Supervisory Patent Examiner

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